

Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

PCT/EP2003/013247



Applicant's or agent's file reference K 60 481/7 ch	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP2003/013247	International filing date (day/month/year) 25 November 2003 (25.11.2003)	Priority date (day/month/year) 28 November 2002 (28.11.2002)
International Patent Classification (IPC) or national classification and IPC B42D 15/00		
Applicant GIESECKE & DEVRIENT GMBH		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of 7 sheets, including this cover sheet.

☒ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 1 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 21 June 2004 (21.06.2004)	Date of completion of this report 10 March 2005 (10.03.2005)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

# INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP2003/013247

## I. Basis of the report

### 1. With regard to the elements of the international application:\*

- ☐ the international application as originally filed
- ☒ the description:  
 pages \_\_\_\_\_ 1-14 \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_
- ☒ the claims:  
 pages \_\_\_\_\_ 1-22, 24-26 \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, as amended (together with any statement under Article 19  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_ 23 \_\_\_\_\_, filed with the letter of \_\_\_\_\_ 25 January 2005 (25.01.2005)
- ☒ the drawings:  
 pages \_\_\_\_\_ 1/2-2/2 \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_
- ☐ the sequence listing part of the description:  
 pages \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_

### 2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item. These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

### 3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

### 4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/fig \_\_\_\_\_

### 5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).\*\*

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rule 70.16 and 70.17).

\*\* Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP 03/13247

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. Statement**

Novelty (N)	Claims	24-26	YES
	Claims	1, 2, 5, 8, 11, 14, 15, 17-21, 23	NO
Inventive step (IS)	Claims	24-26	YES
	Claims	3, 4, 6, 7, 9, 10, 12, 13, 16, 22	NO
Industrial applicability (IA)	Claims	1-26	YES
	Claims		NO

**2. Citations and explanations****1. Claims 1 to 23:****1.1. Novelty:**

1.1.1. The present application does not satisfy the requirements of PCT Article 33(1) because the subject matter of independent claims 1, 17, 21 and 23 and of dependent claims 2, 5, 8, 11, 14, 15 and 18 to 20 within the meaning of PCT Article 33(2).

1.1.2. Document D1 (US-B-6 474 695), which is considered the closest prior art, discloses (cf. abstract; column 2, line 40 to column 7, line 6; figures 1 to 10 and examples 3 and 5) a security element with all of the features of claims 1, 2, 5, 8, 11, 14 and 15, a security paper with all of the features of claims 17 to 20, a value document with all of the features of claim 21 and a valuable article with all of the features of claim 23; see e.g.:

"1. security element (1) with a covering layer (3) having blank spaces (4) in the form of characters or patterns (column 5, lines 35 to 38) that form a first item of visually and/or mechanically readable information (column 5, lines

35 to 38), characterized in that a printed image (column 5, line 65 to column 6, line 16) is arranged in register in the blank spaces (4) (column 6, lines 11 to 16: "... only present in the area of the blank areas ..."), said image forming a second item of visually and/or mechanically readable information (column 6, lines 14 to 16: "... printed ... white layer of color or a metal coating"), the first (column 5, lines 34 to 39) and the second (column 6, lines 14 to 16) items of information being different from each other",

and:

- opaque covering layer consisting of metal (column 5, lines 31 to 45);
- surface relief in the form of a diffraction structure (column 6, lines 33 ff.);
- multicolored printed image (column 6, lines 2 to 6);
- letters (figures 1 and 10);
- security threads (abstract).

## 1.2. Inventive Step

1.2.1. Dependent claims 3, 4, 6, 7, 9, 10, 12, 13, 16 and 22 do not contain any features that, in combination with the features of any claim to which they refer back, meet the requirements for inventive step within the meaning of PCT Article 33(3)). The reasons are as follows:

1.2.2. Claims 3, 4, 6, 7, 9, 10, 12 and 16:

The features of dependent claims 3, 4, 6, 7, 9, 10, 12 and 16 have already been used for the same purpose in a similar security element:

- (a) With regard to claims 3, 6, 7, 9 and 16, see document D2 (WO-A-99/04983), in particular page 3, line 15 to page 5, line 2, claims 1 to 24 and figures 12 to 16.
- (b) With regard to claims 4, 10 and 12, see document D3 (US-A-6 030 691), particularly the abstract, column 4, line 30 to column 6, line 44 and figures 1 to 12.

It would thus be obvious for a person skilled in the art also to apply said features to like effect in a security element according to document D1 and in this way arrive at a security element as per claims 3, 4, 6, 7, 9, 10, 12 and 16.

1.2.3. Claims 13 and 22:

Dependent claims 13 and 22 concern only a minor structural modification to the security element according to claim 1 and the value document according to claim 21, respectively, of the kind that a person skilled in the art routinely makes on the basis of familiar considerations, especially since the resulting advantages are readily foreseeable. Consequently, the subject matter of claims 13 and 22 also does not involve an inventive step.

2. Claims 24 to 26:

2.1. Independent Claim 24:

2.1.1. Prior Art:

Document D1 (US-B-6 474 695), which represents the closest prior art, discloses a method according to

claim 24 for producing a security element with a printed image and a covering layer, said covering layer having blank spaces in the form of characters or patterns, characterized in that the covering layer with the blank spaces is first applied to a supporting film and in that said printed image is then ... generated in register in the blank spaces of the covering layer.

#### 2.1.2. Problem

Providing a method for producing a security element that avoids the disadvantages presented on page 1, second paragraph, to page 4, first paragraph, of the introductory part of the description. In so doing, a visually pleasing embodiment of the security element should be combined with low production costs, even for small-quantity pressings or series with a varying information content.

#### 2.1.3. Solution:

The specific combination of all of the features of claim 24, primarily the printed image produced in register that is **printed digitally** according to the characterizing part of claim 24, is neither described in nor suggested by the prior art, and said claim therefore involves an inventive step within the meaning PCT Article 33(3).

#### 2.2. Dependent Claims 25 and 26:

Dependent claims 25 and 26 define advantageous embodiments of a production method having all of the features of independent claim 24.